



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,057	09/25/2000	Bruce Brumberg	BRUM-101	2821
7590	06/21/2006		EXAMINER PATEL, JAGDISH	
Robert K Tendler 65 Atlantic Avenue Boston, MA 02110			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/669,057	BRUMBERG, BRUCE	
	Examiner	Art Unit	
	JAGDISH PATEL	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 3/31/06.

Response to Amendment

2. Claims 1, 3-16 have been amended. Claims 1-16 are currently pending in the application.

Response to Arguments

3. Applicant's arguments with respect to claims 1-16 rejection over prior art of Macey and "Share the Wealth" have been considered but are moot in view of the new ground(s) of rejections.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites limitation "using the modeling" lacks proper antecedent basis in the claim because the claim does not specify or define what the modeling is. The storing limitation recites "stock option modeling calculations" but does not teach any scope of the model or the modeling. Alternatively it is stated that in order to perform the "stock option modeling

Art Unit: 3624

calculations” the method claim must specify the particulars of the model such as it relates to the (properties of the) company stock and the user defined parameters.

Claims 1-16 are further rendered indefinite because the calculating of the projected stock option exercise outcome is entirely based upon the “what-if parameters” and independent of the information about the individual stock option plan stored in the server. It is unconceivable that the outcome of the stock option outcome is calculated without the specific details of the stock option plan and the stock

Claims 1-16 are further rendered indefinite due to ambiguity concerning the step of calculating a projected stock option exercise outcome as the specific process step(s) included in the calculations are not clearly described in the specification. In particular, the term “the what-if *parameters other than mortality risk relating to the specific company stock*” is vague and unclear in light of the calculations being performed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 3624

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. The amended claims refer limitation “the calculating including consideration of a what-if scenario using a proposed set of user-specified what-if parameters other than mortality risk relating to the specific company stock the calculating being related to gain upon exercise of an option based on the proposed set of what-if parameters”.

8. There is no written description supporting the aforementioned calculation of a projected stock option exercise outcome which includes consideration of a what-if scenario using a proposed set of user-specified what-if parameters other than mortality risk relating to the specific company stock.

In consideration of the aforementioned deficiencies and lack of written description in the specification, the claimed invention(s) is interpreted as a method of calculating a value of a stock option based upon a user specified parameters (noting that “what-if parameters” are user selected hypothetical inputs concerning the stock option). A more detailed analysis is provided below.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3624

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over article "PayCheckCity.Com Adds New Paycheck Calculators and Features To Successful Website, Market Wire, May, 2000 in conjunction with associated a website page of the PayCheckCity.Com dated June 9, 2000. (see date at the bottom which reads "20000609").

12. The PayCheckCity.Com articles cited above teaches a method of providing stock option exercise outcome that is a result of modeling calculations done at a central server (note the user provides various inputs which forms the "what-if" parameters to a web server) and the server in response provides a projected stock option exercise outcome ("the stock option calculator computes the withholding to be paid when the stock options are exercised"). The PayCheckCity.Com articles further teaches, inherently, that the information about the individual's stock option plan relative to a specific stock of the company is stored in the (web-server) because this information is indispensable in calculation of the stock option outcome because the stock option is exercised in some future date and the outcome of the stock option exercise is strongly dependent upon the charter of the stock option plan and the performance of the underlying stock of the company.

Art Unit: 3624

13. It would have been obvious to one of ordinary skill in the art at the time of invention to formulate the process of claim 1 in view of the aforementioned references because such a method would allow an employee of the company who is beneficiary of the company stock option to analyze and manage his own personal stock option by exercising the stock option at the most appropriate time and price. Furthermore, providing such a method over a computer network would greatly improve the accuracy, reliability and availability of the stock option calculations aiding the management of the individual's stock option plan.

14. The PayCheckCity.Com fails to teach providing information about the stock option plan to the individual over the Internet.

Official Notice is taken that providing information about the employee benefit accounts such as terms and conditions regarding the benefit plans that provide valuable information to the employees is old and well known in the art,

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention modify the applied references in view of the official notice because providing the stated information to the individual would allow him to expertly manage the stock option account within the frame work of the terms and conditions of the employee stock option plan.

15. Note that no patentable weight is accorded to the limitation "to permit the individual to make decisions which will result in the optimization of the value of the individual plan" since this limitation is only intended use of the "information about the stock option plan. Alternatively, it is also asserted that this limitation is met by the cited prior art in view of the analysis provided.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3624

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.



Jagdish N. Patel

(Primary Examiner, AU 3624)

6/6/66